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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/715,408

11/19/2003

Mark Meister

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12/05/2005

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EXAMINER

LIM, KRISNA

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 12/05/2005

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/715,408
Filing Date: November 19, 2003
Appellant(s): MEISTER ET AL.

J. Randall Beckers
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 25, 2005 appealing from the Office action mailed March 23, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interference

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of claims

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(4) Status of Amendments

The statement of the status of amendment after final contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of the invention contained in the brief is correct.

(6) Grounds of rejection to be reviewed on appeal

The amendment filed 12/13/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The newly added material which is not supported by the original disclosure is as follows: a) the specification does not mention or disclose at all that a user does not create the electronic mail message; b) the applicant fails to point out where the newly added feature is disclosed in the specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claims 1 and 6-11 are anticipated under 35 U.S.C. §102 by US Patent No. 6,073,113 to Chrabaszcz.

Chrabaszcz anticipated (e.g., see Fig. 3) the invention substantially as claimed. Taking claims 1, 6, 7, 8, 9, 10, 11, 12 and 13 as exemplary claims, the reference anticipated an e-mail method, comprising the steps of:

- a) recognizing whether a complete electronic mail message having a valid recipient address is to be sent (e.g., see items 306 to 312 of Fig. 3), after a send function has been initiated (304 of Fig. 3), from a sending side to a receiving side;
 - alerting a system user on the sending side as to the message being sent (314 of Fig. 3); and
 - allowing the user to authorize sending of the message, or stopping transmission of the message until authorized by the user, or providing the user with an opportunity to consider canceling transmission of the message until authorized by the user [(e.g., when the user clicks on the "Send" button of the email program) (e.g., see col. 1, line 67, to col. 2, line 9)].

While the applicant newly added the additional language "not created by a user" to clarify that a complete electronic mail message not created by a user, this feature on contrary contradict to the original disclosure that discloses that a user who the one composed a message (e.g., see paragraph 26 of page 4 of the specification).

Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chrabaszcz [U.S. Patent No. 6,073,133] in view of Rollins [U.S. Patent No. 6,434,601].

As to claims 1-11, while Chrabaszcz discloses a method that ensures an electronic mail message is complete before the message is transmitted to its recipient(s) (e.g., see the abstract, col. 1, lines 58-61) and the method for verifying the message when a user is finishing composing the message [(e.g., when the user clicks on the "Send" button of the email program, col. 1, line 67, to col. 2, line 9)]. And, Chrabaszcz further discloses the feature that alters the user and allows the user to modify the message before the message is sent. While Chrabaszcz discloses that the e-mail message consists of three sections: a

header (to include addressee(s), title, return address, etc.), a body and attachments (if any) (e.g., col. 1, lines 18-21), Chrabszcz does not mention the modification of an addressee list or erase the message. Such modification or correction of an addressee's e-mail address is clearly taught by Rollins (e.g., see an abstract). Since both of these two references are directed to a method of ensuring error free before sending out e-mail to the recipient(s), it would have been obvious to one of ordinary skilled in the art at the time the invention was made to combine the teaching of Rollins into Chrabszcz because by incorporating the teaching of Rollins into Chrabszcz would enhance more options for the user to modify the e-mail messages.

(7) **Arguments**

In the remarks, for new matter objection, on pages 3-7, appellants' argued in substance that:

a) Unauthorized agent including computer virus, Trojan horse, and non-owner, does adequately describe, for purposes of compliance with the written description requirement of 35 U.S.C. § 112, paragraph 1, the term (or phrase) "not created by a user" and that such a term is not new matter.

b) Similarly to the In re Smythe application, the subject application disclosed a species (virus, Trojan horse, and non-owner) of two genera, not a user and unauthorized agent. Although the subject matter coverage of both genera is not perfectly congruent, the use of the term "not created by a user" in the subject invention would naturally occur to a person of ordinary skill in the relevant art reading the description of the use of virus, Trojan horse, and non-owner in sending emails.

c) While the term **"not create by a user"**, **encompasses species that aren't unauthorized agents**, the specification clearly conveys to the person of ordinary skill in

the relevant art that in this invention, the characteristics of not a user are important to the e-mail alerting function work.

d) It is submitted that the Applicant's disclosure of a trojan horse and a virus in the specification of the subject applicant adequately supports the claim terminology "not created by a user". In regards to the section 112 written description requirement.

e) A virus is clearly something that is not the user. A message created by a virus is a mail message "not created by a user." And, A trojan horse is also clearly something that is not the user. A message created by a trojan horse is a mail message "not created by a user."

f) At col. 1, line 65 thru col. 2, line 3, and claims 6 and 13 of the parent Patent No. 6,671,718, note that mail can be sent by a virus and that the mail is sent by "an unauthorized agent, such as a virus, creates a mail message not created by a user of the mail system user since users are authorized. It is submitted that the claim limitations added via amendment emphasizing that the user does not create the mail are supported by the specification and the claim limitations are not new matter.

In the remarks, for art rejection of claims 1-13, on pages 7-11, appellants' argued in substance that:

g) Chrabaszcz teaches and suggests nothing about alerting when a complete electronic mail message not created by a user is a message that is to be sent.

h) Both Chrabaszcz and Rollins discuss user created messages. There is no teaching or suggestion in Chrabaszcz and Rollins of recognizing whether a complete electronic mail message not created by a user is a message that is to be sent.

i) Neither Chrabaszcz nor Rollins teach or suggest alerting about a message to be sent or allowing the user to authorize sending of the alerted message.

j) Neither Chrabaszcz nor Rollins teach or suggest the send function to be activated by an unauthorized agent.

k) Claim 3 calls for the unauthorized agent to comprise one of a virus, a trojan horse and an agent other than an owner of a mail source. Chrabaszcz and Rollins disclose sending by users not these types of unauthorized agents.

l) Claim 6, calls for stopping transmission of the message until authorized by the user. Chrabaszcz notifies the user of missing attachment and Rollins of bad addresses and neither stop message transmission until authorized by the user. As soon as a message is found to have all of it's attachments (Chrabaszcz) or a correct destination address (Rollins) transmission is accomplished.

m) In claim 7 calls for allowing a user an "opportunity to consider canceling transmission". This cancellation is not considered in Chrabaszcz and/or Rollins because only attachments and destinations are considered.

n) In claim 8 calls for displaying the message that was "not created by the user" after the send has been initiated. Chrabaszcz and/or Rollins teach no such display.

o) In claim 9 is directed to an apparatus in which an alert occurs for "a complete e-mail message not created by a user" is a message that "is to be sent".

(8) Claims Appendix

An appendix containing a copy of the claims involved in the appeal.

(9) Response to Arguments

In response to paragraphs 7 a) to 7 f) above, the appellants are reminded that the term "**virus**" was mentioned only once in the **background sections** of both the present application and Patent No. 6,073,133 which is the parent of this present

application. Moreover, the term **“unauthorized agent including computer virus, Trojan horse, and non-owner”** has never mentioned or addressed in both specification of the present application and the parent case. In the parent case, only once that the term “unauthorized agent” was mentioned (e.g., see col. 7, last line) **and this kind of claimed language was added during the prosecution of the parent.** The original submitted claims mentioned nothing about an unauthorized agent and it should not be entered in the parent case just like the term **“not created by the user”** and **“unauthorized agent including computer virus, Trojan horse, and non-owner”** in the claims of the present invention because those added language was not clearly disclosed or mentioned in the original specification and the current specification.

Thus, the amendment filed 12/13/04 and the newly added claims in the present invention contain non-supported disclosure, which should not be allowed because it introduces new matter into the disclosure as 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention.

In response to paragraphs 7 g) to 7 o) above, as mentioned above, both Chrabasszcz and Rollins disclosed a method that ensures an electronic mail message is complete before the message is transmitted to its recipient(s) (e.g., see the abstract, col. 1, lines 58-61) and the method for verifying the message when a user is finishing composing the message [(e.g., when the user clicks on the “Send” button of the email program, col. 1, line 67, to col. 2, line 9)]. And, Chrabasszcz further discloses the feature that alters the user and allows the user to modify the message before the message is sent. And, Rollins disclosed the feature that allows modification or correction of an addressee’s e-mail address (e.g., see an abstract). Appellant then tried to overcome both Chrabasszcz and Rollins by adding the additional language “not created by a user” to clarify that a complete electronic mail message not created by a user, this feature on contrary contradict to the original disclosure that discloses that a user who

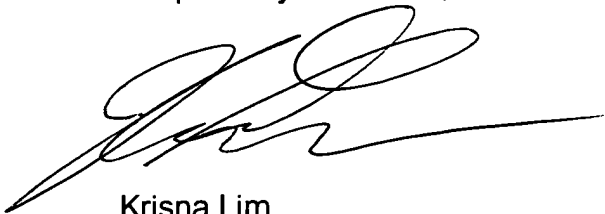
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the one composed a message (e.g., see paragraph 26 of page 4 of the specification).

Moreover, this added term or language is not fully disclosed as mention above.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Krisna Lim

Art Unit 2153

November 28, 2005

Conferees:

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